Attorney's Docket No.: 4860P1403C2   <u>Patent</u>

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In Re Application of:

   Alan R. Peterson, et al.

Application No.: 09/844,921

Filed: April 26, 2001

Art Unit: 2191

Examiner: Ted T. Vo

For: METHOD AND APPARATUS FOR
     STORING AND REPLAYING
     CREATION HISTORY OF
     MULTIMEDIA SOFTWARE OR
     OTHER SOFTWARE CONTENT

Confirmation No.: 3534

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANT'S BRIEF TRANSMITTAL

Sir:

    Enclosed for consideration is Appellant's Appeal Brief pursuant to 37 C.F.R. §41.37(a) for the above-referenced case. This Brief is submitted in response to the Final Office Action mailed from the Examiner on November 30, 2006.

    Check No. __10812__ in the amount of $500.00 is enclosed to cover the filing fee for this Appeal Brief. If any other fees are required to process this Brief, please charge Deposit Account No. 02-2666. A duplicate of this sheet is provided for deposit account charging purposes.

                Respectfully submitted,

                BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Date: __May 7, 2007__

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025
(408) 720-8300

                James C. Scheller, Jr.
                Reg. No. 31,195

(stamp: OIPE MAY 15 2007 PATENT & TRADEMARK OFFICE)

FEE TRANSMITTAL FOR FY 2006

Effective on 12/08/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).

TOTAL AMOUNT OF PAYMENT ($) 500.00

Complete if Known:

Application No.	09/844,921
Filing Date	04/26/2001
First Named Inventor	Alan R. Peterson, et al.
Examiner Name	Ted T. Vo
Art Unit	2191
Attorney Docket No.	4860.P1403C2

_____ Applicant claims small entity status. See 37 CFR 1.27.

METHOD OF PAYMENT (check all that apply)

__x__ Check _____ Credit Card _____ Money Order _____ None _____ Other (please identify)

_____ Deposit Account

Deposit Account Number : __02-2666__

Deposit Account Name: _____

__X__ The Director is Authorized to do the following with respect to the above-identified Deposit Account:

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FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Large Entity		**Small Entity**				
Fee Code	Fee ($)	Fee Code	Fee ($)	**Fee Description**		**Fees Paid ($)**
1011	300	2011	150	Utility application filing fee		_____
1111	500	2111	250	Utility search fee	1,000/500	_____
1311	200	2311	100	Utility examination fee		_____
1012	200	2012	100	Design application filing fee		_____
1112	100	2112	50	Design search fee	430/215	_____
1312	130	2312	65	Design examination fee		_____
1013	200	2013	100	Plant filing fee		_____
1113	300	2113	150	Plant search fee	660/330	_____
1313	160	2313	80	Plant examination fee		_____
1004	300	2004	150	Reissue filing fee		_____
1114	500	2114	250	Reissue search fee	1,400/700	_____
1314	600	2314	300	Reissue examination fee		_____
1005	200	2005	100	Provisional application filing fee		_____

SUBTOTAL (1) $ 0.00

Based on Form PTO/SB/17 (12-04) as modified by BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP on 12/13/04

1

2. EXCESS CLAIM FEES

	Extra Claims	Fee from below	Fees Paid ($)
Total Claims _____ − 20 or HP = _____		X $50.00	= _____

HP = highest number of total claims paid for, if greater than 20

Independent Claims _____ − 3 or HP = _____   X $200.00 = _____

HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims _____ = _____

Large Entity		Small Entity		
Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description
1202	50	2202	25	Each claim over 20
1201	200	2201	100	Each independent claim over 3
1203	360	2203	180	Multiple dependent claims, if not paid
1204	200	2204	100	Reissue: each claim over 20 and more than in the original patent
1205	50	2205	25	Reissue: each independent claim more than in the original patent

SUBTOTAL (2) $ 0.00

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each add'l 50 or fraction thereof	Fee from below	Fees paid ($)
_____ − 100 =	_____ / 50 =	_____ (round up to whole number)	X $250.00	_____

Large Entity		Small Entity		
Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description: Application size fee for each additional group of 50 sheets beyond initial 100 sheets (count spec & drawings except sequences & program listings):
1081	250	2081	125	Utility
1082	250	2082	125	Design
1083	250	2083	125	Plant
1084	250	2084	125	Reissue

SUBTOTAL (3) $ 0.00

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FEE CALCULATION (continued)

4. OTHER FEE(S)

Fees Paid ($)

Non-English Specification, $130 fee (no small entity discount) _____

Large Entity		Small Entity			
Fee Code	Fee ($)	Fee Code	Fee ($)	Fee Description	Fees Paid
1051	130	2051	65	Surcharge - late filing fee or oath	_____
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	_____
1053	130	1053	130	Non-English specification	_____
1812	2,520	1812	2,520	For filing a request for ex parte reexamination	_____
1813	8,800	1813	8,800	Request for inter parties reexamination	_____
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	_____
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	_____
1251	120	2251	60	Extension for reply within first month	_____
1252	450	2252	225	Extension for reply within second month	_____
1253	1,020	2253	510	Extension for reply within third month	_____
1254	1,590	2254	795	Extension for reply within fourth month	_____
1255	2,160	2255	1,080	Extension for reply within fifth month	_____
1401	500	2401	250	Notice of Appeal	_____
1402	500	2402	250	Filing a brief in support of an appeal	500.00
1403	1,000	2403	500	Request for oral hearing	_____
1451	1,510	1451	1,510	Petition to institute a public use proceeding	_____
1452	500	2452	250	Petition to revive – unavoidable	_____
1453	1,500	2453	750	Petition to revive - unintentional	_____
1501	1,400	2501	700	Utility issue fee (or reissue)	_____
1502	800	2502	400	Design issue fee	_____
1503	1100	2503	550	Plant issue fee	_____
1462	400	1462	400	Petitions to the Commissioner (CFR 1.17(f) Group I)	_____
1463	200	1463	200	Petitions to the Commissioner (CFR 1.17(g) Group II)	_____
1464	130	1464	130	Petitions to the Commissioner (CFR 1.17(h) Group III)	_____
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	_____
1806	180	1806	180	Submission of Information Disclosure Stmt	_____
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	_____
1809	790	2809	395	For filing a submission after final rejection (see 37 CFR 1.129(a))	_____
1814	130	2814	65	Statutory Disclaimer	_____
1810	790	2810	395	For each additional invention to be examined (see 37 CFR 1.129(b))	_____
1801	790	2801	395	Request for Continued Examination (RCE)	_____
1802	900	1802	900	Request for expedited examination of a design application	_____
1504	300	1504	300	Publication fee for early, voluntary, or normal pub.	_____
1505	300	1505	300	Publication fee for republication	_____
1803	130	1803	130	Request for voluntary publication or republication	_____
1808	130	1808	130	Processing fee under 37 CFR 1.17(i) (except provisionals)	_____
1454	1,370	1454	1,370	Acceptance of unintentionally delayed claim for priority	_____

Other fee (specify) _____ _____

Other fee (specify) _____ _____

SUBTOTAL (4) $ 500.00

*Reduced by Basic Filing Fee Paid

SUBMITTED BY:

Typed or Printed Name: James C. Scheller, Jr.
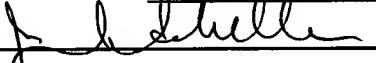
Signature: _____ Date: May 7, 2007

Reg. Number: 31,195 Telephone Number: 408-720-8300

Send to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450
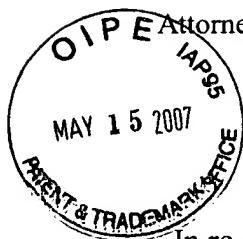
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)	Examiner: Ted T. Vo
)	
Alan R. Peterson, et al.)	Art Group: 2191
)	
Application No.: 09/844,921)	Confirmation No.: 3534
)	
Filed: 4/26/2001)	
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For: METHOD AND APPARATUS FOR)	
STORING AND REPLAYING CREATION)	
HISTORY OF MULTIMEDIA SOFTWARE OR)	
OTHER SOFTWARE CONTENT)	

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF UNDER 37 C.F.R. § 41.37(a)

This is an appeal to the Board of Patent Appeals and Interferences from the decision of

the Examiner dated 11/30/2006, which finally rejected claims 19-21 and 23-39 in the above-

identified application. The Notice of Appeal was received by the PTO on March 5, 2007 and

hence this Appeal Brief is due on May 7, 2007. This Appeal Brief is hereby submitted pursuant

to 37 C.F.R. § 41.37(a).

TABLE OF CONTENTS

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the full interest in the invention, Apple Computer, Inc., 1 Infinite Loop, Cupertino, California, 95014.

II. RELATED APPLEALS AND INTERFERENCES

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal that will directly affect, be directly affected by, or have a bearing on the Board's decision in the instant appeal.

III. STATUS OF CLAIMS

Claims 19-21 and 23-39 are pending in the application and were finally rejected in an Office Action mailed 11/30/2006. Claims 19-21 and 23-39 are the subject of this appeal. A copy of claims 19-21 and 23-39 as they stand on appeal are set forth in the Claims Appendix.

IV. STATUS OF AMENDMENTS

No amendments have been submitted subsequent to the Final Office Action mailed 11/30/2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' invention as claimed in claims 19-21 and 23-39 is directed to an authoring tool for recording the development of the content of a multimedia product and replaying all or part of the recording. The authoring tool receives user events and determines which event or events can be considered as an action as defined in the specification (*see* page 21, lines 13-30 and page 16, lines 1-3). The authoring tool can also determine whether there is any explanation accompanying the recorded action (*see* page 6, lines 16-23 and page 18, line 11 – page 19, line 2). The authoring tool then records the action and the explanation, if any. The playback

mechanism of the present invention allows a user to specify criteria for selecting and playing

back only those recorded actions (and the accompanying explanations, if any) that meet the

criteria, and therefore allowing the user to tailor the playback to meet his/her individual needs

(*see* page 7, lines 17-20; page 29, lines 8-15; and Figure 10).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A.   Whether claims 23-27, 30, 31, and 36-38 fail to comply with the written

description requirement under the first paragraph of 35 U.S.C. § 112.

B.   Whether claims 23 and 28-31 are unpatentable under 35 U.S.C. § 102(b) over

Hamakawa et al., "Object Composition and Playback Models for Handling Multimedia Data",

Proceedings of the first ACM International Conference on Multimedia, Pages: 273-281, August

1993 (hereinafter "Hamakawa").

C.   Whether claims 19-21, 23-39 are unpatentable under 35 U.S.C. § 102(b) over

Hardman et al., "Structure Multimedia Authoring", Proceedings of the first ACM International

Conference on Multimedia, Pages: 283-289, August 1993 (hereinafter "Hardman").

VII. ARGUMENT

A.   Claims 23-27, 30, 31 and 36-38 comply with the written description requirement under the first paragraph of 35 U.S.C. § 112

In rejecting the above claims under the first paragraph of 35 U.S.C. § 112, the Examiner

alleges that the claims contain subject matter which was not described in the specification of the

present application (hereinafter "the specification") in such a way as to reasonably convey to one

skilled in the relevant art that the inventors, at the time the application was filed, had possession

of the claimed invention (Final Office Action mailed on 11/30/2006, page 5). The Examiner further alleges that the application has an effective filing date on 9/30/1994, and that the specification does not describe "computer readable medium having stored thereon executable computer program instructions" where the term computer readable medium used in the later technology includes a very high memory density such as CD ROM, flash memory, or extendable memory devices, wire/wireless media, which were not common in 1994 or not mentioned in the specification. Thus, the Examiner concludes that the specification does not cover or describe how the recorder is related to "computer readable medium", and that the feature "computer readable medium having stored thereon executable computer program instructions" is clearly a "new subject matter".

The current law governing the written description requirement states that to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003). The subject matter of the later claim need not be described literally or "in haec verba" in order for the specification to satisfy the description requirement. *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795 (CCPA 1971).

The specification clearly supports "A computer readable medium having stored thereon instructions for causing a computer to perform a method...." At least the following portions of the specification, in conjunction with at least Figures 1 and 2, clearly describe (and hence provide a written description of) such a computer readable medium:

> FIG. 1 illustrates generally one example of a computer system incorporating the invention. Referring thereto, the computer system 100 comprises a bidirectional system bus 102 interconnecting a processor 104 such as a central processing unit (CPU), memory 106, one or more output devices 108 and one or more input devices 110. The memory 106 typically comprises random access

memory (RAM) for temporary storage of information and/or read only memory (ROM) for permanent storage.

Optionally, the computer system includes a mass storage unit 112 such as a disk drive which is connected either directly or indirectly to the system bus 102. For descriptive purposes, the memory 106 and the mass storage unit 112 are collectively referred to as "storage" when data can be stored in any type of data storage unit.
(p. 9, line 24 - p.10, line 2)

FIG. 2 illustrates generally the layers of software 130 incorporated into the computer system of FIG. 1 when the invention is incorporated into an authoring tool for multimedia products.
(p. 11, lines 1 - 3)

The software 130 is stored in **memory** 106 or stored in **mass storage unit** 112 and then loaded into memory when executed. The software 130 includes an operating system 132 for controlling and coordinating the computer system 100.
(p. 11, lines 9 - 12, emphasis added)

It can be seen that these portions of the specification describe a computer readable medium (e.g. memory 106 and/or storage unit 112) that has stored instructions to cause the computer to perform the methods described in the application.

In determining whether the specification contains enough written description to support claims 23-27, 30, 31 and 36-38, the Examiner errored in applying a test of whether a category of computer readable medium (e.g., CD ROM, flash memory, or extendable memory devices, wire/wireless media) was literally described in the specification. The Examiner also errored in focusing on the high memory density feature of the category, rather than on the general attribute of all computer readable medium, namely, the capability of storing information. One skilled in the art can reasonably understand that CD ROM, flash memory, extendable memory devices, and wire/wireless media are memory and/or mass storage unit. Memory and mass storage unit are clearly described in the specification. The above quoted sections of the specification amply indicate that Applicants intended to use the terms "memory" and "mass storage unit" to cover any existing and future developed types of computer readable medium. The fact that some types

of storage medium have high memory density is irrelevant to the issue of whether Applicants have possession of the invention, namely, a computer-readable medium having stored thereon instructions for causing a computer to perform a method recited in each corresponding claim. Neither is the fact that some types of storage medium did not exist at the time of filing of the present application relevant to the current issue. To require Applicants to disclose something that did not exist at the time of filing would be to impose an impossible burden on Applicants, and thus on the patent system. There cannot, in an effective patent system, be such a burden placed on the right to broad claims. This burden works against the policy of stimulating invention and encouraging early disclosure of an invention.

Thus, at least for the foregoing reasons, claims 23-27, 30, 31 and 36-38 comply with the written description requirement under the first paragraph of 35 U.S.C. § 112.

B.   Claims 23 and 28-31 are patentable under 35 U.S.C. § 102(b) over Hamakawa

1.   Claim 23 is patentable over Hamakawa.

Claim 23 recites, in pertinent part:
displaying a starting state of multimedia content;
determining automatically which recorded actions satisfy a specified criteria; and
playing back a sequence of only those determined recorded actions in chronological order on an output device.
(Emphasis added)

In contrast, Hamakawa does not teach or suggest the above emphasized limitations. Hamakawa discloses an object composition model and a playback model for handling multimedia data (Abstract). The object composition model deals with the static aspects of multimedia objects. Users create a composite object by combining multimedia objects according to certain designated methods. The object playback model deals with the objects for playing

back multimedia objects. Hamakawa, however, contains no discussion of, nor does it hint at, the concept of "action," which is explicitly defined in the present application as "a goal-directed set of events which has an effect or consequence on the software title or content, thereby progressing the development of the software title or content." (p. 16, lines 1 - 3).

Referring to the last paragraph of the left column on page 279 of Hamakawa, the Examiner alleges that Hamakawa teaches or suggests the limitation of <u>determining automatically which recorded actions satisfy a specified criterion</u>. The cited section discloses that the playback mechanism frequently checks current real time and determines which frame in a video should be displayed. However, a <u>frame of a video</u> is <u>not</u> an "<u>action</u>" within the meaning of the definition of "action" in the present application. Likewise, playing back frames of a video is completely different from playing back a sequence of recorded actions, each of which contains a set of events that has an effect or consequence on software title or content.

Even assuming *arguendo* that a frame may be considered as an action as defined by the specification, Hamakawa does not teach or suggest determining which recorded actions satisfy a specified criterion and playing back <u>only</u> the determined actions. As disclosed by Hamakawa, the criterion of deciding whether a frame in a video should be displayed is that whether <u>displaying or skipping</u> the frame would achieve the accurate playback rate, <u>not</u> that whether the frame itself satisfies the criterion. Thus, Hamakawa does not teach or suggest the limitation of <u>determining automatically which recorded actions satisfy a specified criterion</u>. As a further result, Hamakawa certainly does not teach or suggest <u>playing back a sequence of only those determined recorded actions in chronological order on an output device</u>. Thus, at least for the foregoing reasons, claim 23 is patentable over Hamakawa.

2.   Claims 28 and 30 stand or fall together. Claim 28 is the representative claim.

Claim 28 recites, in pertinent part:
>displaying a starting state of the content; and
>**playing back recorded actions in chronological order on said output device, an action from said recorded actions comprising a sequence of at least one event, wherein said at least one event is selected to constitute said action based on a preset criterion.**
>(Emphasis added)

In contrast, Hamakawa does not teach or suggest the above emphasized limitation. As discussed above, Hamakawa does not teach or suggest the concept of "action". Further, Hamakawa does not teach an "action…comprising a sequence of at least one event, wherein said at least one event is selected to constitute said action based on a preset criterion." There is no such preset criterion in the reference which is used to select an event to be constituted as an action. Thus, at least for the above reasons, claims 28 and 30 are patentable over Hamakawa.

3.   Claims 29 and 31 stand or fall together. Claim 29 is the representative claim.

Claim 29 depends on claim 28 and further contains the limitation of "wherein:

at least one action from said recorded actions is accompanied by an explanation and said playing back further comprises playing back any associated recorded explanations along with recorded actions" (emphasis added).

In contrast, Hamakawa does not teach or suggest that at least one recorded action is accompanied by an explanation and that playing back the action includes playing back the accompanying explanation. As discussed above, Hamakawa contains no discussion of an "action" as defined in the specification, much less of any discussion regarding playing back an explanation accompanying an action while playing back the action.

The Examiner alleges that Hamakawa's Figure 7 on page 288 teaches or suggests the above emphasized limitation of claim 29. Figure 7 illustrates an example of a composite object which is comprised of a video object (scene) and an audio object (narration). The discussion of

Figure 7 discloses how the narration object is timed so as to be centered on the precise middle of the video portion. Figure 7, however, contains no discussion or indication of an action and an explanation accompanying the action, within the meaning of the definition of action in the specification. Therefore, at least for the further reason presented above, claims 29 and 31 are patentable over Hamakawa.

C. Claims 19-21 and 23-39 are patentable under 35 U.S.C. § 102(b) over Hardman

1. Claims 19 and 39 stand or fall together. Claim 19 is the representative claim.

Claim 19 recites:
19. A method for recording and reviewing actions performed during development of software content created using a tool on a computer system having a processor and memory, said method comprising:
    receiving one or more user events;
    determining which events and sequences of events constitute actions;
    determining whether an explanation accompanies an action;
    recording the determined actions; and
    recording the determined explanations such that a recorded explanation
of a recorded action is associated with the recorded action.
(Emphasis added)

In contrast, Hardman does not teach or suggest the above emphasized limitations. Hardman discloses a rich hypermedia document model allowing structure-based composition of multimedia presentations and the specification of synchronization constraints between constituent media items (Abstract). Citing Hardman's left column of page 286, the Examiner alleges that the cited section teaches or suggests determining which events and sequences of events constitute actions. As disclosed in Hardman on page 285, the multimedia presentation has a hierarchical structure whose leaf nodes are the data nodes which are played in the presentation and whose non-leaf nodes are composite nodes containing a collection of other composite nodes and/or data nodes. The cited section (left column of page 286) continues to discuss the hierarchical structure and uses Figure 3 as an example. Thus, the multimedia presentation is a

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combination of multimedia data. The cited section, however, does not teach or suggest an action as defined in the present invention, much less <u>determining which events and sequences of events constitute actions</u>.

The Examiner further alleges that the left column of Hardman's page 286 teaches or suggests <u>determining whether an explanation accompanies an action</u>. Specifically, the Examiner suggests that "node names, explicit duration, comment" disclosed in the cited section may be considered as an explanation. However, as discussed above, Hardman does not teach or suggest action. Thus, even assuming *arguendo* that "node names, explicit duration, comment" may be considered as an explanation, Hardman does not teach an explanation <u>accompanying</u> an <u>action</u>.

In addition, Hardman does not teach or suggest <u>recording the determined actions and recording the determined explanations such that a recorded explanation of a recorded action is associated with the recorded action</u>, which are recited in claim 19. As discussed above, Hardman discloses a hierarchical structure that organizes different types of multimedia objects. Hardman, however, does not teach or suggest that the hierarchical structure is a result of <u>recording</u>. Neither does Hardman teach or suggest that the multimedia objects contained in the multimedia presentation constitute recorded actions within the meaning of the definition of action in the specification. The Examiner cites section 4.3 of Hardman as the support of disclosing the recording limitations of claim 19. However, except disclosing the flexibility provided to a user to play any portion of the multimedia presentation, section 4.3 contains no discussion or indication regarding recording actions and explanations associated with the recorded actions.

Thus, for the above reasons, claims 19 and 39 are patentable over Hardman.

2.   Claim 21 is patentable over Hardman.

Claim 21 depends on claim 19 and further contains the limitation of "**wherein said determining whether an explanation accompanies an action includes prompting a user for an explanation with respect to an action being recorded**" (emphasis added). Hardman does not teach or suggest this further limitation recited in claim 20.

In rejecting claim 21, the Examiner cites section 4.3 of Hardman as the source of disclosure of the above emphasized limitation of claim 21. However, as discussed above, section 4.3 contains no discussion or indication of recording anything, much less of recording an action and an explanation associated with the action, within the meaning of the definition of action in the specification. Neither does section 4.3 teach or suggest prompting a user for an explanation with respect to an action being recorded. Thus, for this further reason, claim 21 is patentable over Hardman.

3.   Claim 23 stands or falls separately.

Claim 23 recites the limitations of <u>determining automatically which recorded actions satisfy a specified criterion, and playing back a sequence of only those determined recorded actions in chronological order on an output device</u>. Hardman does not teach or suggest these limitations. As discussed above, Hardman does not teach or suggest the concept of "action" as defined in the specification. Neither does Hardman teach or suggest recording actions.

The Examiner, however, cites Hardman's section 4.1.2 on page 286, figures 3-4 and section 4.3 on page 288 as support in alleging that Hardman teaches or suggests these limitations. The cited sections, however, disclose how to create a hierarchical structure and assigning multimedia <u>data nodes</u> at the leaves of the structure and how a player may control <u>the playing of the multimedia presentation</u>. The hierarchical structure and the data nodes contained are not <u>actions</u> within the meaning of the definition of action in the specification. Thus, even though any selection in the hierarchical structure (composite node or data node) can be played, what is selected is <u>multimedia data</u>, not an <u>action</u>. Thus, Hardman does not teach or suggest <u>determining</u>

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automatically which recorded actions satisfy a specified criterion, and much less playing back a sequence of only those determined recorded actions in chronological order on an output device. At least for the foregoing reasons, claim 23 is patentable over Hardman.

4.   Claims 24 and 25 stand or fall together. Claim 25 is the representative claim.

Claim 25 recites the limitation of "determining automatically which recorded actions to play back by determining which recorded actions meet a specified fixed criteria". As discussed above for claim 23, Hardman does not teach this limitation.

Claim 25 further recites a limitation of "if said received user event does not indicate a playback request, then determining whether there is an action to record and recording the action if it is determined that there is an action to record". Because Hardman does not teach or suggest the concept of "action" ad defined in the specification, Hardman also does not teach or suggest determining whether there is an action to record and recording the action if so, such as recited in claim 25. Thus, at least for this additional reasons that Hardman does not teach this limitation further recited in claim 25, claim 25 together with claim 24 are patentable over Hardman.

5.   Claims 28, 30 and 32 stand or fall together. Claim 28 is the representative claim.

Claim 28 recites the limitation of playing back recorded actions in chronological order on said output device, an action from said recorded actions comprising a sequence of at least one event, wherein said at least one event is selected to constitute said action based on a preset criterion. Hardman does not teach or suggest this limitation. As discussed above, Hardman does not teach or suggest the concept of "action" as defined in the specification. Section 4.3 of Hardman discloses a player that provides a user the flexibility of playing any portion of a multimedia presentation, but not recorded actions. Further, Hardman does not teach or suggest a

recorded action that comprises a sequence of at least one event selected based on a preset criterion. Thus, at least for the above reasons, claims 28, 30 and 32 are patentable over Hardman.

6.   Claims 35 and 36 stand or fall together. Claim 35 is the representative claim.

Claim 35 recites the limitations of "determining which events and sequences of events constitute actions; and recording the determined actions rather than recording the individual events constituting those actions".

As discussed above for claim 19, Hardman does not teach or suggest the limitation of determining which events and sequences of events constitute actions. Also as discussed above, Hardman does not teach or suggest recording actions. Certainly, Hardman does not teach or suggest recording the determined actions rather than recording the individual events constituting those actions. At least for the foregoing reasons, claims 35 and 36 are patentable over Hardman.

7.   Claim 26 is patentable over Hardman.

Claim 26 recites, in pertinent part:
the **action class list** comprises a plurality of action class description fields, each
       action class description field having a first field containing data which
       specifies a particular action class and a second field containing data which
       specifies a generic explanation of the action specified in the corresponding
       first field,
wherein the action class list is used during playback of an action to determine
       an explanation associated with the action class of the action and to
       accompany the played back action with the determined explanation.
(Emphasis added).

In contrast, Hardman does not teach or suggest the above emphasized limitations. As discussed above, Hardman does not teach or suggest action. Thus, Hardman also does not teach or suggest action class list. The Examiner, however, alleges that Hardman's Figure 3 teaches or

suggests an action class list. Hardman's Figure 3 discloses a hierarchical structure. The hierarchical structure contains composite nodes or data nodes (containing multimedia data), not actions, such as recited in claim 26.

Further, also as discussed above for claim 19, Hardman does not teach or suggest determining whether an explanation is associated with an action. Thus, Hardman does not teach or suggest using the action class list during play back of an action to determine an explanation associated with the action class of the action and to accompany the played back action with the determined explanation. Thus, claim 26 is patentable over Hardman.

8.   Claims 20, 29, 31, 33 and 37 are patentable over Hardman.

Claims 20, 29, 31, 33 and 37 each depends on an independent claim that is patentable over Hardman. Further, each of claims 20, 29, 31, 33 and 37 recites either recording or playing back an explanation that is associated with a recorded action. As discussed above, Hardman does not teach or suggest recording an explanation associated with a recorded action, neither does Hardman teach or suggest playing back such a recorded explanation. Thus, claims 20, 29, 31, 33 and 37 are patentable over Hardman.

VIII. CONCLUSION

For all the above reasons, Appellants respectfully submit:

A.   Claims 23-27, 30, 31, and 36-38 comply with the written description requirement under the first paragraph of 35 U.S.C. § 112.

B.   Claims 23 and 28-31 are patentable under 35 U.S.C. § 102(b) over Hamakawa.

C.   Claims 19-21 and 23-39 are patentable under 35 U.S.C. § 102(b) over Hardman.

Appellants respectfully request that the Board reverse the rejections on claims 23-27, 30, 31, and 36-38 under the first paragraph of 35 U.S.C. § 112, the rejections on claims 23 and 28-31 under 35 U.S.C. § 102(b), and the rejections on claims 19-21 and 23-39 under 35 U.S.C. § 102(b) and direct the Examiner to enter a Notice of Allowance for claims 19-21 and 23-39.

Enclosed is a check in the amount of $500.00 to cover the fee for filing a brief in support of an appeal as required under 37 C.F.R. § 1.17(c) and § 41.20(b)(2). Authorization is hereby given to charge our Deposit Account No. 02-2666 for any charges that may be due. If an extension is required, Appellants hereby request such extension.

Respectfully Submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

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James C. Scheller, Jr.
Reg. No.: 31,195

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1030
(408) 720-8300

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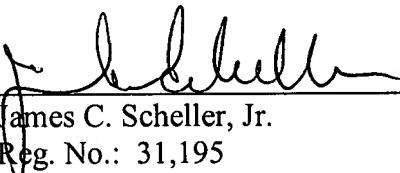
IX. CLAIMS APPENDIX

1-18. (Canceled)

19. (Previously presented) A method for recording and reviewing actions performed during development of software content created using a tool on a computer system having a processor and memory, said method comprising:

receiving one or more user events;

determining which events and sequences of events constitute actions;

determining whether an explanation accompanies an action;

recording the determined actions; and

recording the determined explanations such that a recorded explanation of a recorded

action is associated with the recorded action.

20. (Previously presented) A method as defined in claim 19, said method further comprising:

receiving a user request for playback of recorded actions;

accessing recorded actions and associated recorded explanations; and

playing back recorded actions and any associated recorded explanations.

21. (Previously presented) A method as defined in claim 19, wherein said determining whether as explanation accompanies an action includes prompting a user for an explanation with respect to an action being recorded.

22. (Canceled)

23.   (Previously presented) A computer-readable medium having stored thereon instructions for causing a computer to perform the following method comprising:

displaying a starting state of multimedia content;

determining automatically which recorded actions satisfy a specified criteria; and

playing back a sequence of only those determined recorded actions in chronological order on an output device.

24.   (Previously presented) A computer-readable medium having stored thereon instructions for causing a computer to perform a method comprising:

receiving a user event;

determining whether said received user event indicates a playback request; and

if said received user event indicates a playback request, then determining automatically which recorded actions to play back by determining which recorded actions meet a specified criteria and playing back those determined recorded actions and if said received user event does not indicate a playback request, then determining whether there is an action to record and recording the action if it is determined that there is an action to record.

25.   (Previously presented) A computer-readable medium having stored thereon instructions for causing a computer to perform the following method comprising:

receiving a user event;

determining whether said received user event indicates a playback request; and

if said received user event indicates a playback request, then determining automatically which recorded actions to play back by determining which recorded actions meet

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a specified fixed criteria, said fixed criteria being selectable from a plurality of fixed criteria, and playing back those determined recorded actions and if said received user event does not indicate a playback request, then determining whether there is an action to record and recording the action if it is determined that there is an action to record.

26.   (Previously presented) A computer-readable medium having stored thereon executable computer program instructions, the executable computer program instructions including an action class list and, when executed by a digital processing system, causing the system to perform a method for playback of actions from the action class list, wherein:

the action class list comprises a plurality of action class description fields, each action class description field having a first field containing data which specifies a particular action class and a second field containing data which specifies a generic explanation of the action specified in the corresponding first field,

wherein the action class list is used during playback of an action to determine an explanation associated with the action class of the action and to accompany the played back action with the determined explanation.

27.   (Previously presented) A computer-readable medium as defined in claim 26 wherein said second field identifies a software routine capable of producing an explanation based upon properties of a recorded action.

28.   (Previously presented) A method for playing back actions recorded during development of content created using a tool on a computer system having a processor, memory and an output

device, the tool having a user-selectable playback initiating mechanism for initiating the playback, said method comprising:

displaying a starting state of the content; and

playing back recorded actions in chronological order on said output device, an action from said recorded actions comprising a sequence of at least one event, wherein said at least one event is selected to constitute said action based on a preset criterion.

29.   (Previously presented) The method of claim 28, wherein:

at least one action from said recorded actions is accompanied by an explanation and said playing back further comprises playing back any associated recorded explanations along with recorded actions.

30.   (Previously presented) A computer-readable medium having stored thereon instructions for causing a computer to perform the following method comprising:

displaying a starting state of content; and

playing back recorded actions in chronological order on an output device, an action from said recorded actions comprising a sequence of at least one event, wherein said at least one event is selected to constitute said action based on a preset criterion.

31.   (Previously presented) The computer-readable medium of claim 30, wherein:

at least one action from said recorded actions is accompanied by an explanation and said playing back further comprises playing back any associated recorded explanations along with recorded actions.

32.   (Previously presented) An apparatus for playing back actions performed during development of content created using a multimedia creation tool on a computer system having a processor and memory, said apparatus comprising:

a user interface means for receiving user events, receiving user requests for playback of actions and displaying recorded actions; and

a playback module coupled to said user interface module for receiving user request for playback of recorded actions and for displaying playback of recorded actions, an action from said recorded actions comprising a sequence of at least one event, wherein said at least one event is selected to constitute said action based on a preset criterion, said playback in response to such a user request playing back recorded actions.

33.   (Previously presented) The apparatus of claim 32, wherein:

at least one action from said recorded actions is accompanied by an explanation and said playing back further comprises playing back any associated recorded explanations along with recorded actions.

34.   (Previously presented) The apparatus of claim 32, wherein:

said playback is based on determining automatically which recorded actions satisfy a specified arbitrary criteria.

35.   (Previously presented) A method for recording and reviewing actions performed during development of content created using a tool on a computer system having a processor and memory, said method comprising:

receiving user events;

determining which events and sequences of events constitute actions; and

recording the determined actions rather than recording the individual events constituting those actions.

36.   (Previously presented) A computer-readable medium having stored thereon instructions for causing a computer to perform the following method comprising:

receiving user events;

determining which events and sequences of events constitute actions; and

recording the determined actions rather than recording the individual events constituting those actions.

37.   (Previously presented) The computer-readable medium of claim 36, wherein the operations further comprise:

determining whether an explanation accompanies an action; and

recording the determined explanations such that a recorded explanation of a recorded action is associated with the recorded action.

38.   (Previously presented) The computer-readable medium of claim 36, wherein:

said determining comprises determining which events and sequences of events constitute actions by applying one of a plurality of granularities, said one of a plurality of

granularities being selected based on criteria, whereby said applied one of a

plurality of granularities varies depending on the criteria.

39.   (Previously presented) An apparatus for recording and reviewing actions performed

during development of content created using a tool on a computer system having a processor and

memory, said apparatus comprising:

     a user interface means for receiving user events which occur during development of

          content; and

     a recorder module coupled to receive user events from said user interface means, said

          recorder module determining which events and sequences of events constitute

          actions and recording those actions, said recorder module capable of recording an

          explanation for each individual action, said explanations being recorded in a

          manner which associates a recorded explanation of a recorded action with the

          recorded action.

X. EVIDENCE APPENDIX

No other evidence is submitted in connection with this appeal.

XI. RELATED PROCEEDINGS APPENDIX

No related proceedings exist.